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|--|-------------|----------------------|---------------------|------------------|
| APPLICATION NO.                                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/512,081                                       | 11/08/2004  | Martin Kreyenschmidt | 260985US0PCT        | 2789             |
| 22850  | 7590        | 07/30/2008           | EXAMINER            |                  |
| OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. |             |                      | COONEY, JOHN M      |                  |
| 1940 DUKE STREET                                 |             |                      |                     |                  |
| ALEXANDRIA, VA 22314                             |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1796                |                  |
|  |             | NOTIFICATION DATE    | DELIVERY MODE       |                  |
|  |             | 07/30/2008           | ELECTRONIC          |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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|                              |                                      |   |
|------------------------------|--------------------------------------|---|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/512,081 | <b>Applicant(s)</b><br>KREYENSCHMIDT ET AL. |
|                              | <b>Examiner</b><br>John Cooney       | <b>Art Unit</b><br>1796                     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 April 2008.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-3-6 and 8-21 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 19-21 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,3-6,8-11 and 13-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/06)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

Applicant's arguments filed 4-30-08 have been fully considered but they are not persuasive.

***Election/Restrictions***

Newly submitted claims 19-21 are directed to non-elected species of invention.

Since applicant has received an action on the merits for the originally presented species of invention, this species of invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Initial Comments Regarding Specification***

***& Related Notes Regarding Non-Elected Claim 21***

Applicants' disclosure in the specification giving specific meaning to the inhibitors of the invention is acknowledged(see page 1 lines 12-16). However, it is seen to be of little or no meaning in limiting the inhibitors of the claims in any patentable because the language of the specification is merely stating the effects that the inhibitors are "intended" to impart rather than actually imparting the stated effects.

Though claim 21 has been constructively withdrawn from consideration at this time, it should be noted that claim would be objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Additionally, the claim is confusing as to intent because of its lack of further limitation to the claim from which it depends and it does not set forth any positive process step and/or it can not be determined what positive process step is intended.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-6,8-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dany et al.(3,847,843) in view of DE 100 50 417.

Dany et al. discloses preparations of polyurethane foam compositions as defined by applicants prepared from isocyanates and polyols containing materials that further include compounds reading on the inhibitors elected by applicants (see column 5 and example 2, as well as, the entire document).

Dany et al. differs from applicants' claims in that they do not encapsulate their active agent in wax. However, DE-'417 discloses that it is known to encapsulate an active agent in wax in polyurethane synthesis operations for the purpose of inhibiting the active agent's effects (see translated abstract, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have encapsulated the active agents of Dany et al. in the manner provided for by DE-'417 for the purpose of inhibiting their active effects in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The additional effects of the waxes and particles of applicants claims are held and maintained to be intrinsic qualities associated with the wax materials provided by the teachings of the prior art and effects arriving from the encapsulation of the materials identified. Additionally, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Claims 1, 3-6, 8-11, and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 00/66643 in view of DE 100 50 417.

WO-00/66643 discloses preparations of polyurethane foam compositions as defined by applicants prepared from isocyanates and polyols containing materials that further include compounds reading on the inhibitors elected by applicants (see abstract and applicants' admissions at page 2 of their supporting disclosure, as well as, the entire document).

WO 00/66643 differs from applicants' claims in that they do not encapsulate their active agent in wax. However, DE-'417 discloses that it is known to encapsulate an active agent in wax in polyurethane synthesis operations for the purpose of inhibiting the active agent's effects (see translated abstract, as well as, the entire document).

Accordingly, it would have been obvious for one having ordinary skill in the art to have encapsulated the active agents of WO-643 in the manner provided for by DE-417 for the purpose of inhibiting their active effects in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

The additional effects of the waxes and particles of applicants claims are held and maintained to be intrinsic qualities associated with the wax materials provided by the teachings of the prior art and effects arriving from the encapsulation of the materials identified. Additionally, it has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402. Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

Applicants' arguments have been considered. However, rejections are maintained as set forth above to reflect changes to the claims. It is held and maintained that the secondary DE-417 reference is adequate in addressing the deficiencies of the primary references in that it provides for the encapsulation of an active agent in order to inhibit their effects in the systems involved. Applicants' assertions that the instant inventors are concerned with achieving different effects are unpersuasive and they do

not substitute for the required fact based showing of new or unexpected results that are commensurate in scope with the scope of their claims.

Showings of new or unexpected results need to establish the following:

Results Must be Unexpected:

Unexpected properties must be more significant than expected properties to rebut a *prima facie* case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

Claims Must be Commensurate With Showings:

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to overcome a reasonable case of *prima facie* obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197

USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Applicants' have not persuasively demonstrated unexpected results for the encapsulations of the agents of their claims. Applicants have not clearly demonstrated their results to be unexpected and more than mere optimizations of the knowledge in the art or more significant than being secondary in nature. Applicants' have not demonstrated their showings to be commensurate in scope with the scope of the products and processes as claimed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796

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| <b>Application Number</b><br> | <b>Application/Control No.</b>               | <b>Applicant(s)/Patent under Reexamination</b>  |
|   | 10/512,081<br><b>Examiner</b><br>John Cooney | KREYENSCHMIDT ET AL.<br><b>Art Unit</b><br>1796 |